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Gary A. Watkins, et al.

TELEMATICS UNIT LIFE-CYCLE MANAGEMENT
USING VDU FUNCTIONALITY

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REPLY BRIEF

Board of Patent Appeals and Interference
U.S. Patent and Trademark Office
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This Reply Brief is being filed to respond to certain comments and assertions contained in the Examiner's Answer mailed July 21, 2010. Appellant respectfully submits that the analysis and conclusions as to the different rejections are incorrect and therefore requests Board action to overturn the rejections.

§112 Rejection of Claim 18

Pages 6-8 of the Appeal Brief detail the corresponding structure from Appellants' specification and drawings for the different means language complained of by the Examiner. On Page 13 of the Examiner's Answer, the Examiner boils Appellants' arguments down to an assertion that Appellants have "cited that [the claimed functions] are not structure but rather known techniques, proving that no structure has been recited." The Examiner goes on to cite *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323 (Fed. Cir. 2008), asserting that Appellants have done no more than recite the use of software with a general purpose computer to carry out the claimed functions.

Respectfully, this is incorrect. *Finisar* involved a specification that the court found contained essentially “nothing more than a re-statement of the function, as recited in the claim,” quoting from the Markman Order in that case. *Id.*, at 1340. The court found that the disclosure “provides no algorithm or description of structure corresponding to the claimed function.” *Id.* As to the disclosure of an algorithm to support a means plus function limitation, the court continued, saying “[t]his court permits a patentee to express to express that algorithm in any understandable terms, including as a mathematical formula, in prose, ... or as a flow chart, or in any other manner that provides sufficient structure.” *Id.* In this case, Appellants in the Appeal Brief have identified from the specification specific techniques and processes (i.e., algorithms), in prose, for carrying out the recited functions, and have identified the corresponding hardware that is used by those algorithms and that would be readily understood as such by those skilled in the art. Although this is detailed in the Appeal Brief for each of the recited functions, to re-state just one example: the “means for maintaining subscription service data” is described in one exemplary embodiment at Page 14, lines 9-25 of the specification in conjunction with Fig. 2 wherein after enrollment the vehicle contacts a service provider and receives from the service provider via the vehicle’s telematics unit maintenance event triggers including subscription service data that is stored in the memory shown in Fig. 2. Because Appellants’ specification does provide more detail than simply restating the claimed function and disclosing that it can be implement in software, the Examiner’s rejection on the basis of the holding in *Finisar* is misplaced and not supported by that decision.

Accordingly, given that the specification provides an adequate identification of structure and programmable algorithms/techniques/processes that can be used with that structure to carry out the claimed functions, and because the recognition of this and ability to so configure that disclosed structure will be apparent to those skilled in the art, Appellants submit that the means plus function language from claim 18 is properly supported by the specification and drawings, and reversal of this rejection is therefore respectfully requested.

§103 Rejections

With respect to the various numbered responses by the Examiner contained on Pages 13-21 of the Answer, many of them amount to no more than a quotation of portions of Appellants' arguments followed by an assertion of disagreement and then a substantial repeat of the Examiner's response from the final Office Action, without actually addressing the points made in the Appeal Brief about why those Office Action arguments are incorrect. The Appeal Brief addressed those arguments and responses from the final Office Action and so merely repeating them in the Answer does not amount to a rebuttal of the Appeal Brief arguments.

Response 2 on Pages 13-14 of the Answer take issue with Appellants' arguments concerning Messina and states that "[t]he figures used by the appellant are marked as prior art and do not limit the disclosure of Messina." It was not Appellants who "used" those figures, but the Examiner in his rejection. See footnote 8 of the Appeal Brief where this was already addressed by Appellants. The Appeal Brief at Page 9 does address the complete disclosure of Messina as it is relevant to the appealed claims, and the arguments presented there have not been properly rebutted by the Examiner.

Responses 3-5 and 7-8 all involve a fundamental error in the Examiner's rejections under § 103; namely, that he has effectively ignored the limitation in the independent claims that recites "deactivating the vehicle telematics device at the vehicle at the expiration of the subscription service based on the subscription service data," instead choosing to limit his interpretation of this "deactivating" step to require no more than what the subsequent two steps recite. That is, the Examiner reads the claim, not as requiring (1) deactivation of the telematics device based on subscription service data using the steps of (2) placing a communication from the device and (3) surrendering at least one number, but instead as only requiring steps (2) and (3) and asserts that those two steps (2) and (3) by themselves define what is meant by deactivating the telematics device. This interpretation effectively ignores the deactivating limitation from the claim and is an interpretation not supported by the record. Appellants do not confine the meaning of "deactivating" to only those two steps, nor has the Examiner provided any

evidence to support his limited interpretation. Appellants' claimed steps of "deactivating the vehicle telematics device" means just what one of ordinary skill in the art would understand it to mean - that the device is disabled from use for telematics communication by or for the customer until the device is re-activated, if ever. And the fact that Appellants limited their claim to a more specific process that involves steps (2) and (3) does not mean that the claim now no longer requires that the telematics device be disabled.

This unwarranted limitation on the meaning of deactivating has been continued in the Examiner's Answer as reflected in numbered responses 3-5 and 7-8. See, for example, response 3 on Page 14 wherein the Examiner states that deactivating "is described as the following steps 1) placing a communication from the vehicle telematics device and 2) surrendering at least one identification number previously assigned to the vehicle telematics device" and that "[d]eactivating is not drawn to the disabling of the device, but rather the two steps listed above." Again, Appellants disagree with this assertion, as it is without support on the record. Neither the claim nor the specification "describe" deactivating as being those steps, rather, the claims say that the deactivating steps includes those two steps as a part of its process. That is in the nature of using open-ended terminology within a claim, as is discussed at Page 12 of the Appeal Brief.

The Examiner further states at response 8 on Page 18 that the two steps (2) and (3) identified above are "the only positively recited limitations" of the claims. Thus, it is clear that the Examiner has refused to give independent weight to the "deactivating ... based on subscription service data" limitation of these claims. The claims by their express wording and plain meaning state that the telematics unit is deactivated and that it is based on subscription service data, and the two steps (2) and (3) that are used as a part of that deactivation process do not themselves fully amount to disabling of the device, they are but part of the process.

Accordingly, Appellants respectfully submit the Appeal Brief arguments concerning this issue are correct and not properly rebutted by the Examiner.

Response 6 on Pages 16-17 of the Answer is essentially a repeat from the final Office Action and is addressed in the Appeal Brief at Page 11.

Responses 9 and 11 on Page 19 of the Answer are also repeats of the arguments from the final Office Action which are addressed and un-rebutted; see Page13-14 of the Appeal Brief.

Response 10 indicates that Appellants' arguments address the references individually, not in combination. This is incorrect. The Appeal Brief discusses the relevant teachings of the references and identifies why it would not have been obvious to combine them to render the claimed subject matter obvious, or at least identifies why the Examiner has not met his burden to show that they can be so combined.

Responses 12-14 concerning the surrendering of an identification number are just a copy of the arguments from the final Office Action. The Appeal Brief at Pages 14-15 address the deficiencies of the Examiner's arguments and remain un-rebutted.

Finally, with respect to Appellants' arguments concerning the separate rejection of claim 20, the Examiner has not provided any response in the Answer.

Accordingly, for the reasons discussed above and in the Appeal Brief, Appellants respectfully traverses the Examiner's rejections and ask that they be overturned.

The Commissioner is authorized to charge any fees, or refund any overpayments, associated with this Appeal Brief to Deposit Account No. 07-0960.

Respectfully submitted,

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